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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/717,184	11/20/2000	Trevor I. Blumenau	BLU-005	9528
7590 03/17/2009				
David R. Graham 1337 Chewpon Avenue Milpitas, CA 95035			EXAMINER TRAN, PHILIP B	
			ART UNIT	PAPER NUMBER
			2455	
			MAIL DATE	DELIVERY MODE
			03/17/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/717,184

Applicant(s)

BLUMENAU, TREVOR I.

Examiner

Philip B. Tran

Art Unit

2455

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34, 39, 56, 77-94, 99, 112, 121, 124 and 128-192 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 77-94, 99 and 112 is/are allowed.
- 6) ☒ Claim(s) 1-34, 39, 56, 121, 124, 128-192 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ ~~Notes of Informal Patent Application~~
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The analysis under 35 U.S.C. 112, first paragraph, requires that the scope of protection sought be supported by the specification disclosure. The pertinent inquiries include determining (1) whether the subject matter defined in the claims is described in the specification and (2) whether the specification disclosure as a whole is to enable one skilled in the art to make and use the claimed invention. However, the examiner only concentrates on the first determination.

(1) Claims 124 (independent claim) and 128-160 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The "invention" for the purpose of the first paragraph analysis is defined by the claims. The description requirement is simply that the claimed subject matter must be described in the specification. The function of the description requirement is to ensure that the applicant had possession of the invention on the filing date of the application. The application need not describe the claim limitations exactly, but must be sufficiently clear for one of ordinary skill in the art to recognize that the applicant's invention

encompasses the recited limitations. The description requirement is not met if the application does not expressly or inherently disclose the claimed invention.

Specification does not explicitly describe nor is sufficiently clear for one of ordinary skill in art to recognize the following steps as recited in independent claim 124:

- "... **a receiver...** and **a transmitter...**"

Applicant does not cite anywhere in the present application specification indicating that "... **a receiver...** and **a transmitter...**" Thus it is unclear how the present specification can support the claimed limitations "... **a receiver ...** and **a transmitter ...**" in claim 124.

Therefore, claims 124 (independent claim) and 128-160 are unclear that the one ordinarily skilled in the art cannot recognize the encompassed claimed limitations.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-34, 39, 56, 124 and 128-160 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1-34, 39, 56, 124 and 128-160, it is not clear that applicant intended to claim apparatus/device or application/software instruction.

If applicant intended to claim apparatus/device, the apparatus/device cannot be just code/application/software instruction. Within the meaning of 101, a machine/device is "a concrete thing, consisting of parts or of certain devices and combinations of

devices." Burr v. Duryee, 68 U.S. (1 Wall.) 531, 570 (1863)". Therefore, claims 1-34, 39, 56, 124 and 128-160 are incomplete or inaccurate as claimed as apparatus/device.

If Applicant intended to claim application/code/software instruction, the claims 1-34, 39, 56, 124 and 128-160 are just limited to a functional descriptive materials consisting of application per se, instead of being defined as including tangible embodiments (i.e., a computer-readable storage medium such as memory device, storage medium, etc.)

Regarding claims 1-34, 39, 56, 124 and 128-160, it is not clear that "means for receiving" and "means for communicating" and "means for ascertaining", etc. are hardware components or software components. In case if those "means for" are software components, it appears that claims 1-34, 39, 56, 124 and 128-160 are not "apparatus/device" because apparatus/device cannot be just software. Therefore, claims 1-34, 39, 56, 124 and 128-160 are incomplete or inaccurate as apparatus/device.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-34, 39, 56, 124 and 128-160 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are system claims (e.g., claims 22-34 and 148-160 indicate that claims 1-34, 39, 56, 124 and 128-160 are system claims). However, it is not clear that "means for receiving" and "means for communicating" and "means for ascertaining", etc. are hardware components or

software components, given that no explicit hardware embodiments of the "means for" can be found in the specifications. Therefore, the claims are directed to non-statutory subject matter. Correction is required.

5. Claims 121 and 161-192 are also rejected under 35 U.S.C. § 101.

As per claims 121 and 161-192, these appear to be directed toward a method or process for effecting the provision of content cover a network. Based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. ***Diamond v. Diehr*, 450 U.S. 175, 184 (1981); Parker v. Flook**, 437 U.S. 584, 588 n.9 (1978); ***Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).**

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state. In the instant application, applicant's method steps fail the first prong of the new Federal Circuit decision since they are not required to be tied to another statutory class and can be performed without the use of a particular apparatus. Furthermore, the method steps fail to unambiguously require transformation of underlying subject matter to a different

state or thing. The mere steps of identifying, providing, receiving, communicating and ascertaining information is not a transformation and is not statutory subject matter.

Thus, claims 121 and 161-192 are non-statutory since they are not requisitely tied to another statutory class and they do not requisitely transform underlying subject matter to a different state or thing.

Response to Arguments

6. There is no art rejection. Claims 77-94, 99 and 112 are allowable over prior art of record. Claims 124 (independent claim) and 128-160 are rejected under 35 U.S.C. 112, first paragraph. Claims 1-34, 39, 56, 124 and 128-160 are rejected under 35 U.S.C. 112, second paragraph. Claims 1-34, 39, 56, 121, 124 and 128-192 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

7. A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET TO EXPIRE THREE MONTHS FROM THE MAILING DATE OF THIS COMMUNICATION. FAILURE TO RESPOND WITHIN THE PERIOD FOR RESPONSE WILL CAUSE THE APPLICATION TO BECOME ABANDONED (35 U.S.C. § 133). EXTENSIONS OF TIME MAY BE OBTAINED UNDER THE PROVISIONS OF 37 CAR 1.136(A).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tran whose telephone number is (571) 272-3991. The Group fax phone number is (571) 273-8300. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar, can be reached on (571) 272-4006.

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Philip B Tran/
Primary Examiner, Art Unit 2455
Mar 14, 2009